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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,099	12/11/2001	Adam Joseph Kreuzman	X-11650	5642

25885 7590 06/21/2004

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PATENT DIVISION
P.O. BOX 6288
INDIANAPOLIS, IN 46206-6288

EXAMINER

KOSAR, ANDREW D

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,099

Applicant(s)

KREUZMAN ET AL.

Examiner

Andrew D. Kosar

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

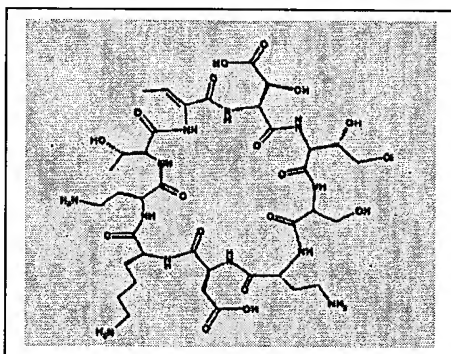
In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I: 3 independent inventions, A process for deacylating an N-acyl side-chain of a pseudomycin.

- A) Claims 1 and 2, in part, and Claim 4, where the nucleus is Structure I.
- B) Claims 1 and 2, in part, where the nucleus is Structure II.
- C) Claims 1, 3, and 4 where the pseudomycin is selected from the group consisting of pseudomycin A, A', B, B', C, and C'.

Group II: 1 independent invention, A compound.

- A) Claim 5, drawn to a compound having the structure:



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Group III: 1 independent invention, A compound.

A) Claims 6 and 7, drawn to a pseudomycin nucleus.

Group IV: 2 independent inventions, A process for deacylating an N-acyl side-chain of a syringomycin.

A) Claims 8 and 9, in part, where the nucleus is Structure III.

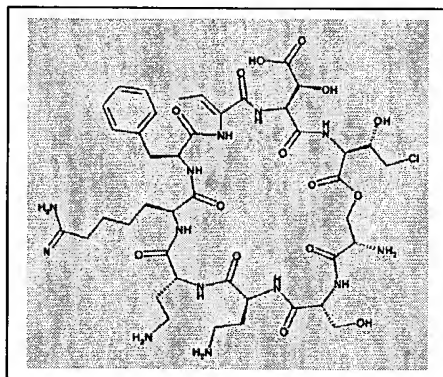
B) Claims 8 and 9, in part, where the nucleus is Structure IV.

Group V: 1 independent invention, A syringomycin nucleus.

A) Claim 10, drawn to a syringomycin nucleus.

Group VI: 1 independent invention, A compound.

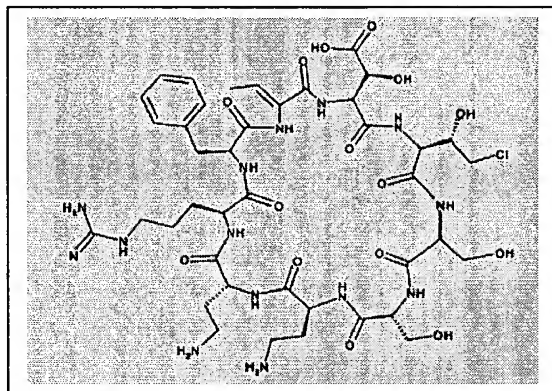
A) Claim 11, drawn to a compound having the following structure:



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Group VII: 1 independent invention, A compound.

A) Claim 12, drawn to a compound having the following structure:



According to PCT Rule 13.2, unity of invention exists only when the shared or corresponding technical feature is a contribution over the prior art. The inventions listed as Groups I-VII do not relate to a single general inventive concept because they lack the same or corresponding special technical feature. The MPEP states that, "[i]f, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) may be raised" (MPEP Appendix A1, Annex B, Part 1(c)(ii)). In the instant case, the technical feature of Group I is the use of ECB deacylase, which is shown by U.S. Patent 5,573,936 to lack novelty, and does not make a contribution over the prior art.

U.S. Patent 5,573,936 teaches that the, "purified ECB deacylase...is useful in a method for deacylating lipo cyclicpeptides to provide the cyclicpeptide nuclei thereof."

Furthermore, the compounds in the instant application are structurally distinct. The compound of Structure I is a cyclic polypeptide comprising nonstandard amino acids, forming a lactone ring through the OH group of serine, leaving the amine free, with a lysine residue, and no arginine or phenylalanine residues, present in the structure, while the compound of Structure IV is a cyclic polypeptide lacking an ester linkage, and thus no free amine group, wherein it has an arginine and phenylalanine residues, but lacks lysine residue.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Because restriction is proper under 35 U.S.C. 121 and 372, and in accordance with 37 CFR 1.499, Applicant is required to elect a single invention to which the claims must be restricted.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew D. Kosar whose telephone number is (571)272-0913. The examiner can normally be reached on Monday - Friday 8am-430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571)272-0961. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anish Gupta
Patent Examiner
Art Unit 1654

Andrew D. Kosar, Ph.D.
June 16, 2004